IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#20
2/25/04
SK

Applicant:	Edward O. Clapper	§	Group Art Unit:	2643
Serial No.:	09/745,836	§	Examiner:	Binh Kien Tieu
Filed:	December 21, 2000	§		
For:	Message Card	§	Atty. Dkt. No:	ITL.0785US (P10784)
Customer No.:	21906	§	Confirmation No.:	8616

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant hereby appeals from the Final Rejection dated September 16, 2003, finally rejecting claims 28 and 30-42.

I. REAL PARTY IN INTEREST

The real party in interest is Intel Corporation, the assignee of the present application by virtue of the assignment recorded at Reel/Frame 011612/0668.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

The application was originally filed with claims 1-24. Claims 25-42 were added and claims 1-27 and 29 were canceled during prosecution. Claims 28 and 30-42 were finally rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

There are no unentered amendments.

V. SUMMARY OF THE INVENTION

FIG. 1 illustrates a system 10 including a communication network 12, and a first communication device 14 and a second communication device 16 coupled to the communication network. Typically, the system may include an arbitrarily large number of such communication devices; only two are shown here, for simplicity. Specification p. 3, lines 12-15.

The communication network includes one or more communication interfaces 38 for connecting to the communication devices. It further includes a communication routing mechanism 40 which directs communications from one communication device to a desired one(s) of the possibly myriad other communications devices. Specification p. 3, lines 28-31.

The communication network further includes an ID service 42 which provides the identification of one communication device to another communication device. In one embodiment, the communication network may be a telephone network, and the global ID service may be the set of services and mechanisms which provide "caller ID". In another embodiment, the communication network may be the internet, and the global ID service may be the set of services and mechanisms which support "instant messaging". In other embodiments, the communication network may be a wireless PDA or pager network or the like. Specification, p. 4, lines 7-13.

In addition to the global ID service, the communication network includes a custom ID service 44. The functionality of the custom ID service will be described in detail below. In various embodiments, the custom ID service may be constructed as a separate entity from the global ID service, while in others, it may be constructed as a sub-service within the global ID service. Specification p. 4, lines 14-17.

FIG. 2 illustrates one embodiment of a differently-configured system 50 utilizing this invention. The system includes a communication network 52 which includes communications interfaces for connecting to a plurality, and typically a large number, of communications devices. The communication network includes a communication routing mechanism and a conventional

ID service 54. The communication network may be constituted in a manner similar to that of the communication network of FIG. 1, except that the ID service 54 does not necessarily include a custom ID service; it may include one (not shown), but is not required to include one. Specification p. 4, lines 18-24.

In this embodiment, the communication network is coupled to a first communication device 14 via which a user desires to communicate with a second communication device 16 coupled to the communication network. In this embodiment, there is a third communication device 60, in which the custom ID service is embodied, coupled to the communication network. Specification p. 4, lines 25-28.

The custom ID service includes a communication interface 62 for connecting to the communication network. The custom ID service also includes an ID checker 64 and an ID modifier 66 which may be coupled to the communication interface and/or to each other. Specification p. 4, lines 29-31.

FIG. 3 illustrates one embodiment of a method of the operation of the system of FIG. 1, to which the reader should also make reference. The method will be explained with reference to a "caller ID" embodiment, but the reader will appreciate that this is by way of illustration and not limitation. The method begins with a user initiating a call to a specified destination (80). If (81) the user is calling from a phone with an unknown or indeterminate caller ID, or if (82) the user inputs a command to indicate that she wishes to override the default caller ID of that phone, the system prompts (85) the user for her personal identification number (PIN) or other suitable identification, which the user inputs (86) through the phone's input device (20). She may do this by entering her PIN on the phone's keypad, or by speaking her pin or password into the telephone system's voice recognition system (not shown), by swiping her calling card through the phone's credit card slot, or the like. Specification p. 5, lines 11-21.

In some embodiments, the system may enable the user to skip some of those steps by simply inputting her PIN (83). In some embodiments, if the user does none of those, the invention is not invoked, and the system routes the call normally and provides its usual caller ID information (84) to the destination phone. Specification p. 5, lines 22-25.

But if the invention is invoked, the custom ID service may require (87) that the user enter a valid PIN or the like. Depending upon the level of security and verifiability which the application requires, the custom ID service may implement various types and degrees of security. In some cases, it may be sufficient that the user has entered a unique PIN number. In other cases, the custom ID service may permit invocation of the method at only pre-determined ones of the communications devices, and not at others (such as pay phones, perhaps). In other cases, it may be sufficient that the user is in physical possession of the calling card. In other cases, there may be strong encryption, voice recognition, multiple levels of authentication, and other such technologies employed. Specification p. 5, line 26 through p. 6, line 2.

If the user inputs a valid PIN or other such identifying information, the custom ID service may look up (88) the user's custom ID information in a database (not shown). The custom ID service may optionally (89) prompt the user to enter alternative information to that stored as the user's default. This may include enabling the user to pick from one or more preset sets of custom ID information. Those may be configurable by the user, or they may be set by the custom ID service. Specification p. 6, lines 3-7.

Ultimately (90), the call is routed to the specified destination, and the system presents the user's selected custom ID information (whether that be the default, preset, or newly-entered information) to the destination phone. Specification p. 6, lines 7-10.

Take the example where Alice is at Betty's house and wishes to phone Carla, but she knows that Carla will not answer the phone if her caller ID screen says the call is from Betty. This invention enables Alice to override this default condition, and cause the system to present Alice's custom ID information on Carla's phone. Alice may cause Carla's phone to present, for example: "Alice", or Alice's home phone number "(505) 555-1313", or "Alice coming to visit you", or whatever she wishes. Specification p. 6, lines 11-16.

FIG. 4 illustrates one exemplary method of operating the system of FIG. 2, to which the reader should also make reference. The method begins (92) with the user (at phone 14) initiating a call not directly to the ultimate destination phone (16), but rather to the phone number of the custom ID service provider (60). The custom ID service prompts (93) the user for her PIN, which the user provides (94), and the custom ID service validates (95). Once a valid identity has

been established, the custom ID service may (96) lookup the user's custom ID information in a database (not shown), and may prompt the user for alternative text, which may include one or more preset messages (97). Once the custom ID information has been selected, the custom ID service re-routes the call, such as by (98) conferencing it or forwarding it, to the destination phone, providing with the call the custom ID information. Specification p. 6, lines 17-26.

In some embodiments, it may be desirable or necessary for the custom ID service to cooperate or negotiate with the communication network. For example, in some embodiments, the communication network might otherwise present the custom service ID service's caller ID, rather than the calling person's custom ID information, to the recipient – unless the communication network and custom ID service have an arrangement to enable the substitution of the desired information. The reader will appreciate that this negotiation may be necessary in order to, e.g., protect the interests of the communication network and prevent fraud on its customers. Specification p. 6, line 27 through p. 7, line 2.

The skilled reader will appreciate that the flowcharts of FIGS. 3 and 4 illustrates but two example of methods by which such systems may operate, and that there are many alternative possibilities. In some other embodiments, various ones of the steps may be left out, or may be reordered, or may be enhanced with additional steps and technologies, yet remain within the scope of this invention. In some embodiments, the custom ID information might be e.g. pre-pended to the normal caller ID information, rather than strictly replacing it. Specification p. 6, line 3 through p. 7, line 8.

FIG. 5 illustrates another embodiment, in which the custom ID information or messages may be pre-programmed into a "message card" 100 (or into the custom ID service for use with a uniquely-identified message card), which could be sold to a user; the user might phone the destination phone or the custom ID service, swipe the message card or enter its serial number, and the custom ID service might in response cause the destination phone to display e.g. "I love you" or "I have left the office, home soon" or what have you; it might even do this without the regular voice portion of the call being completed, resulting in a "call-less call" which transmits only the custom ID information. Specification p. 7, lines 19-25.

The message card includes a memory, such as a magnetic stripe or, in the case of a "smart card", a semiconductor memory device. The memory may include a unique identifier such as a serial number, to enable the custom ID service to prevent fraud from unauthorized duplicate cards. The memory may further include one or more programmed message. In some embodiments, these may be pre-programmed messages. In other embodiments, the user may be allowed to program all or some of the messages. In some embodiments, the messages may be stored at the custom ID service rather than on the card itself. The message card may further include a programmed destination specifier such as a phone number. In some embodiments, this may be a pre-programmed number, while in other embodiments, the user may program it, or the purchaser may have it programmed at the time and point of sale; this may be used by, for example, a parent who purchases an "I am alive and well but too broke to write or call" card for his college student child. In some embodiments, the number may be stored at the custom ID service rather than on the card. The message card may further include a PIN or other security mechanism. In some embodiments, it may be encoded. The message card may further include a monetary value specifier which indicates a remaining money balance on the card, or a remaining number of pre-paid usages, or the like; this may in some embodiments be pre-programmed, while in others it may be left for programming e.g. at the time and point of sale. In the embodiments where various of the data are stored at the custom ID service, they will be indirectly accessed in response to the unique identifier from the card. Specification p. 6, line 27 through p. 7, line 26 through p. 8, line 11.

FIG. 6 illustrates one embodiment of a method of operating a system, such as that of FIG. 1 or FIG. 2, in conjunction with the message card of FIG. 5. The operation begins with the user initiating a call (110). If (111) the message card is used up, or, in other words, if there are no remaining calls or minutes or money on the card, then the operation may terminate (112) unless the user pre-pays for additional usage, such as by authorizing a credit card charge or the like. If there is pre-paid usage remaining or newly authorized, then if (113) the message card requires user authentication or, in other words, if possession of the card is not sufficient, then the user is authenticated (114) such as by entering a password or PIN. Once the usage has been authorized, then if (115) the calling destination is not pre-specified, the user enters the calling destination (116) such as via the phone's keypad. Specification p. 8, lines 12-22.

If (117) the card specifies a fixed message, that message is sent (118). In some embodiments, the fixed message may be printed on the face of the card. If, however, there is no fixed message, then if (119) there are one or more predetermined messages from which the user may select, the user selects (120) one or more of the predetermined messages, which are sent (118). Some or all of the predefined messages may be printed on the card, and the user may select one or more of them, such as by entering their number(s) on the keypad or other suitable entry means. If there are no predetermined messages, the user manually enters (121) the message such as by entering it into the keypad or by speaking it to a voice recognition system or to an operator, and the message is sent (118) to the destination communication device. In another embodiment, the list of predetermined messages may include a "tbd" message which, when selected by the user, causes the system to prompt the user and enable the user to manually enter a non-predetermined message. If (122) the communication is to also include conventional usage of the communication devices, such as a spoken phone call, then the call is connected (123) from the calling phone to the destination phone. Specification p. 8, line 22 through p. 9, line 2.

While the invention has been described with reference to a "caller ID" service within a telephone network, the user will appreciate that it may be applied to other applications. Specification, p. 9, lines 3-4.

VI. ISSUES

A. Does Snyder Anticipate Claim 40?

B. Does Snyder Teach Storing A New Message In A Memory At A Time Later Than The Manufacturing Of A Calling Card?

C. Does Snyder Teach A Predetermined Message to Replace The Caller ID Value For The Telephone At Which A Calling Card Is Used?

D. Is Claim 28 Obvious Over Snyder In View Of Tasaki?

E. Does Taskett Overcome The Deficiencies Of Snyder Alone Or Snyder In View Of Tasaki, And If So Is There A Suggestion Or Motivation To Combine The Teachings?

VII. GROUPING OF THE CLAIMS

Claims 34, 36, 40 and 42 were rejected under 35 U.S.C.§102 (b) as being anticipated by Snyder et al. (U.S. Patent No. 5,784,444, hereinafter "Snyder"). For this ground of rejection, the claims do not stand or fall together. Claim 40 is separately patentable from any other claim and stands alone, as does claim 42. Further, claims 34 and 36 form a group that is separately patentable from any other grouping.

Claims 28, 30-32, 37-39 and 41 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Snyder and Tasaki et al. (U.S. Patent No. 4,879,744, hereinafter "Tasaki"). The claims of this group stand or fall together, and are patentable over any other group herein.

Claim 35 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Snyder in view of Taskett (U.S. Patent No. 5,923,734, hereinafter "Taskett"). Claim 33 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tasaki in view of Snyder and in further view of Taskett. Although claims 33 and 35 were rejected under different grounds, they may be grouped to form a group that is separately patentable over any other group.

VIII. ARGUMENT

A. Does Snyder Anticipate Claim 40?

Claim 40 is directed toward a telephone calling card. The telephone calling card comprises a memory having stored therein a plurality of predetermined messages, one or more of the plurality of messages to be received by a recipient communications device in place of the respective caller ID value of a telephone at which the calling card is used. It is respectfully submitted that Snyder does not anticipate claim 40.

1. Does Snyder teach every limitation of Claim 40?

Snyder fails to disclose a telephone calling card having a plurality of predetermined messages stored thereon, a message to be received by a recipient communications device in place of the caller ID value of the telephone at which the calling card is being used. To anticipate a claim, "a reference must disclose every element of the challenged claim." *See, PPG Inc. v. Guardian Indus. Corp.*, 37 U.S.P.Q. 2d 1618, 1624 (Fed. Cir. 1996). Further, to anticipate, the elements must be arranged as in the claim. *See e.g., Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Snyder teaches supplementing a caller ID value. *See*, column 1, line 66 through column 2, line 2. For example, pursuant to Snyder, a telephone station "T" may include a display (34, 36) on which a display screen (200, 250) may appear. Figures 6 and 6A; column 3, lines 1-3; column 4, lines 21-23; column 5, lines 16-20. Generally, information may be displayed on the display screen, including the telephone number of the sending telephone station. Figure 6, at number 202. This information, including the caller ID number, is also displayed on the recipient machine. See Figure 6A, at number 256; column 5, lines 16-32. Therefore, Snyder fails to disclose replacing the caller ID value.

As claim 40 was not rejected in the final Office Action on any other ground, the Board is respectfully requested to reverse the rejection.

2. Are limitations being improperly read into claim 40?

The Examiner seems to take the position that claim 40 requires supplying caller ID information and an additional message to a recipient communications device. Paper No. 16, p. 7. This position is based on the assertion that the specification fails to support the claim as written. *Id.*, p. 8. As such, the claims were examined based on a construction that includes "supplementing a caller ID value" rather than rejecting claim 40 on an alternate ground. *Id.*

The words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. M.P.E.P. § 2111.01. Further, it is impermissible to import subject matter from the specification into a claim. M.P.E.P. § 2111. It is respectfully submitted that the Examiner fails to give the words of claim 40 their plain meaning and impermissibly imports limitations into claim 40. Further, there is support in the specification for claim 40.

There is no dispute that the specification discloses a message card having pre-programmed messages stored thereon. Paper No. 16, p. 8. Further, there is no dispute that a destination communication device receives the pre-programmed message. *Id.* The disagreement is whether the predetermined message stored on the message card can override or replace a caller ID value.

The replacement of a caller ID value with a custom message is outlined in the specification. For example, in a method of operating the system of Figure 1, the default caller ID of the phone that the caller is calling from may be overrode. Specification, p.5, lines 14-16; p. 6, lines 11-16. A caller may use a calling card in conjunction with this method. Specification, p. 5, lines 18-21. Pursuant to an embodiment, custom ID information may be stored in a database. Specification, p. 6, lines 3-4. The custom ID information from the database may be presented to the destination telephone in place of the caller ID information of the phone from which the call is being made. *Id.*, lines 8-10.

In another embodiment, "the custom ID information or messages may be pre-programmed into a 'message card'". Specification, p. 7, lines 18-20 (emphasis added). The user may use the message card to phone a destination phone or the custom ID service. *Id.*, lines 20-21.

The custom ID service might cause the destination phone to display a message where only the custom ID information is transmitted. *Id.*, lines 22-25 (emphasis added). Thus, in some embodiments, custom ID information or messages may be stored on the card rather than a database. As such, it is respectfully submitted that a skilled artisan would understand that a pre-programmed message on the message card might just as easily override caller ID information as custom ID information stored in a remote database.

The replacement of a caller ID value with a custom message was claimed in original claims 21-24. Specifically, original claim 21 is directed toward a telephone calling card. The calling card may be used at any of a plurality of telephones each having a respective caller ID value. The memory of the calling card has stored therein, a substantially unique identifying value and a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. Further, original claim 22 calls for a telephone calling card comprising a memory having stored therein a plurality of predetermined messages for substitution in place of the respective caller ID value. Thus, the specification, including the original claims support claim 40.

Additionally, the title of the invention is "Message Card". Further, the abstract of the disclosure specifies "a message card having a memory bearing a message for substitution in lieu of, for example, a caller ID value at a phone at which the message card is used". Taken together, it is respectfully submitted that a skilled artisan would understand the message on the message card could replace rather than supplement the caller ID information of the phone from which a call is being made. Thus, it is respectfully submitted that the specification, including the original claims support a telephone calling card comprising a memory having stored therein a plurality of predetermined messages to be received by a recipient communications device in place of the respective caller ID value of the telephone at which the calling card is used.

In the Advisory Action the Examiner indicates that claim 40 must be modified due to events that have occurred during prosecution. For example, in the Office Action dated September 6, 2002, the Examiner rejected original claims 21-24 based on the combination of Hazra, et al. (U.S. Patent No. 5,787,154, hereinafter "Hazra") and Malik (U.S. Patent No. 5,903,636, hereinafter "Malik"). In response to the rejection, claims 21-24 were canceled and new claims

28-31 were presented. New claim 28 was directed toward a telephone calling card. The telephone calling card of new claim 28 comprises a memory having stored therein a unique identifying value and, the memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card. Further, new claim 29 called for a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used, whereas new claim 30 called for a plurality of predetermined messages for substitution in place of the respective caller ID value. Thus, new claims 28-31 included subject matter that was similar to that of original claims 21-24.

Thereafter, claims 28, 29, and 31 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hazra in view of Tasaki. Claim 30 was rejected under the same section of the statute as being unpatentable over Hazra in view of Tasaki and in further view of Longo. Notably, the new rejections did not include the Malik reference. In response thereto, the Examiner's characterization of Hazra was disagreed with. For example, the telephone at which Hazra's universal authenticator (UA) is used is merely a medium for communication between the UA and an authentication system without identification of the telephone. Thus, Hazra failed to disclose substituting a predetermined message in place of a caller ID value for a telephone at which a calling card is used. See, Reply to Paper No. 11, dated February 28, 2003. It is respectfully submitted that the Applicant did not forfeit the claim construction sought by asserting an additional argument against the Hazra reference in a subsequent response. Given that new rejections based on the Snyder reference were asserted thereafter, is seems as if the Examiner agreed. Accordingly, claim 40 should not be misconstrued to have additional limitations read into it.

In sum, Snyder does not teach or suggest every limitation of claim 40 when claim 40 is construed according to the plain meaning of its words. As such, Snyder does not anticipate claim 40.

B. Does Snyder Teach Storing A New Message In A Memory At A Time Later Than The Manufacturing Of A Calling Card?

Claim 42 was rejected under 35 U.S.C. § 102(b) as being anticipated by Snyder. Claim 42 depends from claim 40 calling for a memory having a storage area therein for storing a new message, the new message to be stored in the memory at a time later than the manufacturing of a calling card. In the Office Action, column 4, lines 53-56 and lines 65-67 of Snyder are cited. These sections of Snyder teach editing calling card information by using a cursor and edit keys associated with a keyboard. However, there is no mention in these sections of Snyder that any edits are stored on the calling card. Thus, Snyder fails to disclose a new message being stored in a calling card memory after manufacture of the calling card. Because Snyder does not teach every limitation of claim 42, the Board is respectfully requested to reverse the rejection.

C. Does Snyder Teach A Predetermined Message to Replace The Caller ID Value For The Telephone At Which A Calling Card Is Used?

In the Final Office Action, claim 34 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Snyder. Claim 34 is directed toward a calling card. The calling card of claim 34 comprises a memory having stored therein a plurality of predetermined messages to replace the caller ID value for the telephone at which the calling card is used.

Snyder fails to disclose replacement of the caller ID value with a predetermined message. For example, caller ID information is displayed at the recipient telephone station 250. Thus, Snyder supplements rather than replaces the caller ID value with additional indicia. As such, it is respectfully submitted that Snyder fails to anticipate claim 34. Accordingly, the Board is respectfully requested to reverse the rejection of claim 34.

Contrary to the Examiner's assertions, there is support in the specification, including the original claims for the plain meaning of the words of claim 34. For example, in one embodiment, the default caller ID for the telephone that a caller is making a call from may be overridden by a custom ID message. Specification, p.5, line 11 - p.6, line 16. With reference to this embodiment, the custom ID information may be stored on a database. *Id.* However, the embodiment clearly contemplates being used in conjunction with a calling card. *Id.* Thus, it is respectfully submitted

that one with skill in the art would understand that the custom ID information might be stored on a card, such as message card 100 to replace or override a default caller ID value.

Replacement of a caller ID value with custom information is expressed elsewhere in the specification. For example, the specification states, "in some embodiments, the custom ID information might be e.g. pre-pended to the normal caller ID information, rather than strictly replacing it." Specification, p. 7, ll. 7-8 (emphasis added). Thus, custom ID information may replace caller ID information or supplement caller ID information. Further, with reference to the message card 100 embodiment, it is stated that only the custom ID information may be transmitted. Specification, p. 7, ll. 24-25 (emphasis added). Further, in an embodiment where the message card may be used in conjunction with a system, such as the one shown in Figure 1 or Figure 2, it is stated that a message is sent to the destination communications device. Specification, p. 8, ll. 29-30. When this statement is viewed with respect to the teachings of the application as a whole, it is respectfully submitted that the message sent to the destination communication device may supplement or replace the caller ID value.

Original claim 21 clearly supports replacement of caller ID information with a predetermined message. For example original claim 21 was directed toward a telephone calling card. The telephone calling card comprises a memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. Further, original claim 22 called for a plurality of predetermined messages for substitution in place of the respective caller ID value. Thus, it is respectfully submitted that there is support in the specification for the plain meaning of the words of claim 34.

Prior prosecution does not limit the plain meaning of the words of claim 34. Original claims 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hazra in view of Malik. In this rejection, the Examiner admits that Hazra fails to teach a predetermined message for substitution in place of the respective caller ID value of a telephone. Malik was relied on to overcome the deficiencies of Hazra. In response to this rejection, claims 21-24 were canceled and similar subject matter was claimed in new claims 28-31. In particular, claim 28 distinguished over the combination of Hazra and Malik without specifically discussing whether there was a suggestion or motivation to modify Hazra in view of Malik. Nevertheless, the subsequent office

action, Malik was not asserted in combination with Hazra. Rather, new claims 28, 29, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hazra in view of Tasaki. Further, new claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hazra in view of Tasaki and in further view of Longo. With respect to claim 30, the Examiner conceded that the combination of Hazra and Tasaki failed to teach a plurality of preprogrammed custom ID messages. As such, the Examiner relied on Longo, not Malik to overcome the deficiency.

In response thereto, claim 28 was amended to include the subject matter of claim 29, and new claims 32-42 were added. In remarks, it was pointed out that Hazra fails to identify the telephone at which Hazra's universal authenticator is being used. Reply to Paper No. 11, p. 5. Thus, Hazra failed to disclose a predetermined message in place of a caller ID value for a telephone at which the calling card is used. Further, it was pointed out that Hazra in combination with Tasaki and Longo failed to disclose or suggest a telephone calling card memory having stored therein a plurality of predetermined message for substitution in place of the respective caller ID value. *Id.* Simply, Longo does not teach or suggest a telephone calling card having a memory having stored therein a plurality of predetermined messages for substitution in place of the caller ID value. As Hazra does not identify the telephone at which the universal authenticator is being used and Hazra does not teach a predetermined message in place of a caller ID value for a telephone, there was no reason for modify Hazra to substitute a predetermined message in place of a caller ID value for a telephone at which the calling card is being used. Apparently, the Examiner agreed, because the combination of Hazra and Malik was not thereafter asserted against the claims. Thus, it is respectfully submitted that the prior prosecution does not warrant a forfeiture of the plain meaning of the words of claim 34 to improperly import limitations into the claim. Accordingly, the Board is respectfully requested to reverse the §102 (b) rejection of claim 34.

D. Is Claim 28 Obvious Over Snyder In View Of Tasaki?

In the final Office Action, claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tasaki in view of Snyder. Claim 28 is also directed toward a telephone calling card. The calling card comprises in part a memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the

calling card is used. As has been explained with respect to claims 40 and 34, Snyder does not teach substitution in place of the respective caller ID of a telephone at which the calling card is used. Rather, Snyder merely supplements a caller ID value with additional indicia. *See*, Figures 5 and 6.

Again, as has been explained with respect to claims 40 and 34, the specification supports a construction of the plain meaning of the words of claim 28. In particular, the words "a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used" are the exact words previously found in original claim 21. Thus, it is unclear how there cannot be support in the specification for the plain meaning of the words of claim 28.

Moreover, it is respectfully submitted that the meaning of these words has not been changed during prosecution. For example, in the September 6, 2002 Office Action, original claims 21-24 were rejected as being unpatentable over Hazra in view of Malik. In response thereto, claims 21-24 were canceled, being replaced with new claims 28-31 without specifically addressing the suggestion or motivation to modify Hazra in view of Malik. However, in a subsequent response, it was argued that Hazra does not disclose a predetermined message for substitution in place of a respective caller ID value of a telephone at which the calling card is used. Furthermore, Hazra fails to identify a telephone at which its universal authenticator is being used.

In the following Office Action, the Examiner declined to assert a rejection based on the combination of Hazra, Malik and Tasaki. Instead, the Examiner rejected claims 28 and 30-32 as being unpatentable over Tasaki in view Snyder. Thus, it is respectfully submitted that the plain meaning of claim 28 has not been altered, as the Examiner seems to indicate. Specifically, the combination of elements found in claim 28 was never rejected under the combination of Hazra, Malik and Tasaki. Thus, there was no reason to argue over a combination that was never asserted and different arguments were made based on the combination of references asserted by the Examiner. As such, it is respectfully submitted that claim 28 is not obvious over the combination of Tasaki and Snyder. Thus, the Board is respectfully requested to reverse the rejection thereof.

E. Does Taskett Overcome The Deficiencies Of Snyder Alone Or Snyder In View Of Tasaki, And If So Is There A Suggestion Or Motivation To Combine The Teachings?

Claim 33 calls for a plurality of predetermined messages to be printed on a telephone calling card. Likewise, claim 35 calls for a plurality of messages to be printed on a telephone calling card.

Neither Snyder nor Tasaki teach a plurality of messages being printed at a card. As such, the Examiner relies on Taskett. Specifically, the Examiner cites to Taskett's abstract. Col. 5, ll. 15-45, and Col. 6, ll. 47-53. In these passages, visual indicia on a calling card are described.

The visual indicia of Taskett are images such as photographs, reproductions, drawings, or sketches. Col. 5, ll. 17-19. Sounds associated with the visual indicia are communicated back to the user of the card from a service provider. Col. 5, ll. 26-37. These sounds may be animal sounds or instructions to the card user where the instructions are in a voice associated with the visual indicia. Col. 5, ll. 25-28; 37-45. For example, if the card has a picture of Elvis on it, the card user would hear the voice of Elvis after connecting with the service provider.

Nowhere in the cited passages of Taskett is it found where the visual indicia is a predetermined message, much less a predetermined message to replace a caller ID value at a recipient device. As such, it is respectfully submitted that Taskett does not overcome the deficiencies of Snyder alone or Snyder and Tasaki.

Furthermore, the audio sounds associated with the visual indicia are communicated back to the user of the card and not forward to another person. As such, there is no suggestion or motivation to print a predetermined message that replaces a caller ID value on the card of Snyder or Tasaki.

For at least these reasons expressed herein, the Board is respectfully requested to reverse the rejection of claims 33 and 35.

IX. CONCLUSION

The Applicant requests that each of the final rejections be reversed and that the claims subject to this appeal be allowed to issue.

Respectfully submitted,

Date: February 10, 2004

Rhonda L. Sheldon, Reg. No. 50,457
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024-1805
713/468-8880 [Phone]
713/468-8883 [Facsimile]

APPENDIX OF CLAIMS

The claims on appeal are:

28. A telephone calling card comprising:

a memory having stored therein a unique identifying value, said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card, and said memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used.

30. The calling card of claim 28 wherein said memory has stored therein a plurality of predetermined messages for substitution in place of the respective caller ID value.

31. The calling card of claim 30 wherein said memory has a storage area therein for holding a value specifying an account balance, the account balance being stored in the memory at a time later than the manufacturing of a calling card.

32. The calling card of claim 30 wherein one of said plurality of predetermined messages includes an indicator, which when selected, prompts the user to manually enter a message using the telephone at which the calling card is used.

33. The calling card of claim 30 wherein said plurality of predetermined messages are printed on the card.

34. A telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages to replace the caller ID value for the telephone at which the calling card is used.

35. The telephone calling card of claim 34 wherein said plurality of messages are printed on the card.

36. The telephone calling card of claim 34 wherein one of said plurality of predetermined messages includes an indicator to enable manual entry of a message.

37. The telephone calling card of claim 34 wherein said memory has a storage area therein for holding a value specifying an account balance, the account balance being stored in the memory at a time later than the manufacturing of a calling card.

38. The telephone calling card of claim 34 wherein the memory has a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card.

39. The telephone calling card of claim 38 wherein the respective telephone number is be stored in the memory at a time later than the manufacturing of a calling card.

40. A telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages, one or more of said plurality of messages to be received by a recipient communications device in place of the respective caller ID value of a telephone at which the calling card is used.

41. The telephone calling card of claim 40 wherein said memory has a storage area therein holding a value specifying a respective telephone number which is to be called upon usage of the calling card.

42. The telephone calling of claim 40 wherein said memory has a storage area therein for storing a new message, the new message to be stored in the memory at a time later than the manufacturing of a calling card.

AF/2643 $

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No. ITL.0785US

In Re Application Of: **Edward O. Clapper**

Serial No.	Filing Date	Examiner	Group Art Unit
09/745,836	December 21, 2000	Binh Kien Tieu	2643

Invention:

MESSAGE CARD

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: **$330.00**

☒ A check in the amount of the fee is enclosed.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **20-1504 (ITL.785)**

Signature

Dated: **February 10, 2004**

Rhonda L. Sheldon
Registration No. 50,457
8554 Katy Freeway, Suite 100
Houston, Texas 77024-1805
713/468-8880 [Phone]
713/468-8883 [Facsimile]

I certify that this document and fee is being deposited on **February 10, 2004** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature of Person Mailing Correspondence

Rebecca R. Ginn

Typed or Printed Name of Person Mailing Correspondence

cc: